

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Noriyuki ISHIDA et al.

Patent No. 6,402,070

Serial No.: 09/512,935

Filed: February 25, 2000

Issued: June 11, 2002

For: BONE-MILL

Art Unit: 3725

**PETITION FOR RECONSIDERATION OF  
DECISION TO DISMISS PETITION  
PURSUANT TO 37 C.F.R. § 1.378(E) TO  
ACCEPT AN UNAVOIDABLY DELAYED  
PAYMENT OF A MAINTENANCE FEE IN AN  
EXPIRED PATENT TO REINSTATE PATENT**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully respects reconsideration of decision to dismiss petition pursuant to 37 C.F.R § 1.378 to accept an unavoidably delayed payment of a maintenance fee in an expired patent to reinstate patent.

The Office has previously found that Applicant's original Petition showed the following:

- (1) Provided an explanation of the docketing system and procedures of Ai Association (as evidenced by Fumiko Ohtake); and
- (2) Submitted statements by all persons with direct knowledge of the circumstances surrounding the delay.

(See p. 4, Decision on Petition, lines 19-23.)

The Petition was dismissed due to several alleged deficiencies. The Decision on Petition at p. 4, lines 23-28 states,

“However, petitioners did not supply sufficient information regarding the training provided to Mami Kitani, the degree of supervision of her work, and if there were any checks on the described work to assure the proper execution of the assigned tasks. Petitioners must submit this information upon filing a renewed petition in order to show Mami Kitani was sufficiently trained and experienced with regard to the routine for tracking and paying maintenance fees such that reliance upon her represented the exercise of due care.”

Applicant submits herewith the following submissions:

1. A Declaration from Kosaku Inaoka, a senior partner at Ai association of patent and trademark attorneys (hereafter, “Ai”). The Declaration discloses the extensive experience and training of Mami Kitani, the degree of supervision of Mami Kitani’s work, and a description of checks on Mami Kitani’s work to assure proper execution of the assigned task.

2. Appendix 1 to Declaration of Inaoka, a marked-up copy of a letter prepared by Kosaku Inaoka with the assistance of Mami Kitani ordering the filing of the specification and drawings as a new patent application in the U.S., entitled “BONE-MILL” as well as an information sheet indicating M. Kitani’s initials.

3. Appendix 2 to Declaration of Inaoka, a marked up copy of letter prepared by Kosaku Inaoka with the assistance of Mami Kitani, requesting the payment of the issue fee indicating M. Kitani’s initials.

4. Appendix 3 to Declaration of Inaoka, a marked up copy of a letter with an indication that an annuity data had already been inputted to the computer.

As indicated in Mr. Inaoka's Declaration, Ms. Kitani has been working for Ai for over 24 consecutive years. She has over 15 years of experience managing deadlines for payment of the issues fees. She was provided on the job training by a Senior Partner at Ai association, Mr. Inaoka, pertaining to patent application procedures, including the maintenance fee payment for patent rights in the United States. Mr. Inaoka explains that she has "executed tasks with the most careful attention for about over 15 years...."

There were also significant oversight of Ms. Kitani's work. As evidenced by Mr. Inaoka's Declaration, it is the practice at Ai both an attorney and secretary to check the progress of procedures and deadlines. As such, there were at least two persons at Ai responsible for tracking the maintenance fee procedures.

The Declaration of Kosaku Inaoka also states that the error that resulted in the failure to pay the maintenance fee was the only serious error made by Ms. Kitani in over 24 years. Furthermore, as was noted in Appendix 3 of the Petition submitted November 3, 2010, a thorough review of all the foreign files at Ai association of patent and trademark attorneys revealed no other failures to pay maintenance fees. The fact that there were no other errors in Ai's records is further evidence that Ai's procedures for payment of the issue fees are highly reliable and are performed by highly trained and experienced staff with reliable supervision.

Based on the foregoing, it is respectfully requested that this petition be granted.

Please charge Deposit Account No. 07-1896 the amount of \$400 to cover the reconsideration of the Petition.

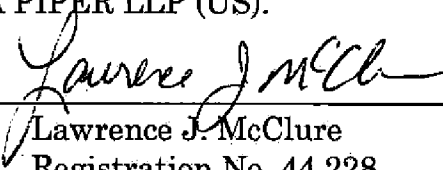
If it should be determined that for any reason either an additional fee needs to be paid or an insufficient fee or an excessive fee has been paid, please charge any insufficiency or credit any overpayment necessary to ensure consideration of the information disclosure statement for the above-identified application to Deposit Account No. 071896.

Respectfully submitted,

DLA PIPER LLP (US).

Date: April 11, 2011

By: \_\_\_\_\_

  
Lawrence J. McClure

Registration No. 44,228

Attorney for Applicant(s)

1999 Avenue of the Stars, Suite 400

Los Angeles, California 90067

Telephone: 310-595-3000

Facsimile: 310-595-3400

## DECLARATION

I, Kosaku Inaoka, am a senior partner in Ai association of patent and trademark attorneys, do declare that the statements below are true and correct under penalty of perjury under the laws of the United States. All statements made herein based on my own knowledge are true and all statements made on information and belief are believed to be true.

Mami Kitani has been working for over 24 consecutive years for mainly my secretary in our firm, Ai association of patent and trademark attorneys (She entered our firm in April 1987). She has experienced with regard to also the routine for tracking and paying maintenance fees. Actually, she has managed deadlines for various procedures including the maintenance fee payment for patent rights in foreign countries and executed tasks with the most careful attention for about over 15 years. (the first 9 years, she was mainly my secretary with my domestic jobs)

She had been to ECC English school (a night school) in OSAKA for brushing up her business English skill during 1994 to 1996. As to the patent applications procedures and the maintenance fee payment for patent rights in foreign countries, I, Kosaku Inaoka, have provided on the job training (OJT) to Maki Kitani.

In our firm, a patent application for the United States is handled by a pair of an attorney and his secretary. The two have been checking each other the progress of the procedures and deadlines. Mami Kitani's work has been expert level.

Regarding the present U. S. Patent No. 6,402,070, I drafted the specification and claims, she helped to make an order letter for filing them as a New Patent Application in U.S.A. "BONE-MILL" as well as an Information Sheet of them (see appendix 1). In February 4, 2002, we were informed that a Notice of Allowance from the U.S. Patent and Trademark Office in connection with the present case. We quickly asked the client whether the issue fee would be paid or not. After we received affirmative instruction from the client, I sent a facsimile letter which was typed by Kitani to the U.S. attorney (see appendix

2).

In July 22, 2002, we received the ribbon copy of United States Letters Patent No. 6,402,070 from the U.S. attorney and a Management card for annuities was printed out by the computer. Because an indication that an annuity data had already been inputted to the computer was stamped (see appendix 3).

After Kitani got the Management card for annuities, she should have handed it to the person in charge of the annuity management; however she seemed to keep it in the Document file Pocket for a few while and unfortunately, she didn't took it out from the pocket by forgotten. This was the only one serious fault about her for more than 24 years her jobs.

In our firm, there was no check system that a secretary had handed the Management card to the person in charge of the annuity management. Mami Kitani did not handed the Management card to the person in charge of the annuity management was out of our firm's assumption.

Date: April 7, 2011

A handwritten signature in black ink, appearing to read 'Kosaku Inaoka', written over a horizontal line.

Kosaku Inaoka, Patent Attorney

# **Appendix 1**

LOEB & LOEB LLP  
A LIMITED LIABILITY PARTNERSHIP  
INCLUDING PROFESSIONAL CORPORATIONS  
ATTORNEYS AT LAW

10100 SANTA MONICA BOULEVARD,  
SUITE 2200, LOS ANGELES,  
CA 90067-4164  
U.S.A.

(Appendix 1)

Ai Association of Patent  
and Trademark Attorneys

Kinyukoko-Sumisei Bldg.  
5-20, Minamihommachi  
4-chome, Chuo-ku  
Osaka 541-0054 JAPAN

Telephone (81) 6-6245-0211  
Facsimile (81) 6-6245-2266  
Facsimile (GIV) (81) 6-6258-7201

February 24, 2000  
Via FACSIMILE & DHL



Re: A New Patent Application in U.S.A.  
"BONE-MILL"  
Our File: 0686-1  
Filing due date: February 25, 2000

Dear Sirs,

Following to our letter of February 22, 2000 in connection with the above-identified case, we send you the Declaration and Assignment forms which we received today by facsimile, Japanese specification and drawings with necessary information by facsimile. The same has been despatched today by DHL courier, together with a certified copy of the priority document. We will sent you the original forms of Declaration and Assignment upon receipt.

We would ask you to file an application with the U.S. PTO based on an INFORMATION SHEET and documents enclosed.

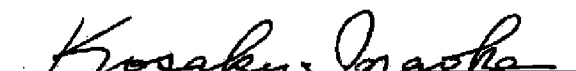
Please acknowledge safe receipt of this letter by return facsimile, upon confirming that all the enclosures described in the enclosure notation has been enclosed.

Sincerely yours,

AI ASSOCIATION OF  
PATENT AND TRADEMARK ATTORNEYS

Ms. Kitani's initial



  
Kosaku Inaoka

KI/mk

Enclosures: Mentioned in the attached sheet

# INFORMATION SHEET

for 0686-1

## 1. Client (Assignee):

Name: KYOCERA CORPORATION  
Address: 6, Takeda Tobadono-cho, Fushimi-ku,  
Kyoto 612-8501, Japan

## 2. Applicant/Inventor (Assignor):

- (1) Name: Noriyuki ISHIDA  
Address: c/o KYOCERA CORPORATION of  
6, Takeda Tobadono-cho, Fushimi-ku,  
Kyoto 612-8501, Japan
- (2) Name: Shingo TAMABUCHI  
Address: c/o KYOCERA CORPORATION of  
6, Takeda Tobadono-cho, Fushimi-ku,  
Kyoto 612-8501, Japan
- (3) Name: Akihiro OOKURA  
Address: c/o KYOCERA CORPORATION of  
6, Takeda Tobadono-cho, Fushimi-ku,  
Kyoto 612-8501, Japan
- (4) Name: Tatsuo OOSUGI  
Address: c/o KYOCERA CORPORATION of  
6, Takeda Tobadono-cho, Fushimi-ku,  
Kyoto 612-8501, Japan
- (5) Name: Nobuo OKA  
Address: c/o MEISEIKINZOKU MFG. CO., LTD. of  
1-2-16, Togo-Dori, Moriguchi-shi,  
Osaka 570-0041, Japan
- (6) Name: Kazutoshi KOYAMA  
Address: c/o MEISEIKINZOKU MFG. CO., LTD. of  
1-2-16, Togo-Dori, Moriguchi-shi,  
Osaka 570-0041, Japan

## 3. Title of the Invention: BONE-MILL

## 4. Priority to be claimed:

Japanese patent application No. 11-047550  
filed on February 25, 1999

## 5. Documents:

Enclosed to follow

Japanese Specification including  
claims and abstract (19 pages).....(x) ( )  
Drawings (Figs. 1-22: 17 sheets) .....(x) ( )  
Certified copy of priority document...(x) ( )  
Assignment (copy).....(x) ( )  
Declaration & Power of Attorney.(copy)(x) ( )

# **Appendix 2**

(Appendix 2)

Mr. Lawrence J. McClure  
HOGAN & HARTSON L.L.P.  
Biltmore Tower  
500 South Grand Avenue, Suite 1900  
Los Angeles, California 90071  
U.S.A.



AI Association of Patent  
and Trademark Attorneys

Kinyukoko-Sumisei Bldg.  
5-20, Minamihommachi  
4-chome, Chuo-ku  
Osaka 541-0054 JAPAN

February 27, 2002

Via Facsimile

Telephone (81) 6-6245-0211  
Facsimile (81) 6-6245-2266

Re: U.S. Patent Application No. 09/512,935  
Noriyuki Ishida et al.  
Your File: 81872.0004  
Our File: 0686-1

Dear Mr. McClure,

Thank you for your letter of January 29, 2002 enclosing  
a Notice of Allowance issued in connection with the patent  
application identified above.

We would ask you to make a payment of the Issue Fee in  
the U.S. Patent and Trademark Office by the April 9, 2002 due  
date.

The client has accepted the Examiner's Amendments.  
There is no need to file a divisional application for the non-  
elected claims 41-43. The client has no information nor  
references to be submitted to the U.S. PTO by way of an IDS  
for the subject application.

Kindly acknowledge safe receipt of this letter by  
return facsimile.

Sincerely yours,

Ms. Kitani's initial



KI/mk

*Kosaku Inaoka*  
Kosaku Inaoka

# **Appendix 3**

(Appendix 3)

HOGAN & HARTSON  
LLP

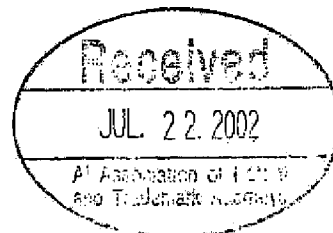
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*an indication  
was stamped*

BILTMORE TOWER  
500 SOUTH GRAND AVENUE, SUITE 1900  
LOS ANGELES, CALIFORNIA 90071  
TEL (213) 337-6700  
FAX (213) 337-6701  
WWW.HHLAW.COM

July 17, 2002

Mr. Kosaku Inaoka  
Ai Association of Patent and Trademark Attorneys  
Kinyukoko-Sumisei Bldg., 5-20, Minamihommachi  
4-Chome, Chuo-ku, Osaka 541-0054 Japan



Re: U.S. Patent No.: 6,402,070  
Issued: June 11, 2002  
Inventor: ISHIDA, et al.  
BONE-MILL  
Your Ref. No.: 0686-1  
Our Docket No.: 81872.0004

Dear Mr. Inaoka:

We are pleased to enclose the ribbon copy of United States Letters Patent No. 6,402,070, and six soft copies, issued June 11, 2002. Please acknowledge receipt by return facsimile.

Assignee may now begin to mark the products with the word "Patent" (or "Pat.") followed by the patent number. We encourage you to do so since failure to mark may jeopardize your right to recover damages from an infringer. It will not, however, invalidate the patent.

The term of the patent begins on the date on which the patent issued, and ends twenty years from the date on which the application for the patent was filed in the United States, or, if the application contains a specific reference to an earlier filed application or application under 35 U.S.C. §§ 120, 121, or 365(c), the term ends twenty years from the date on which the earliest such application was filed.

If there is a terminal disclaimer filed on this patent, the patent term will end at the time specified in the terminal disclaimer. This will typically be shorter than the full term of the patent if calculated as described above.

WASHINGTON, DC

BERLIN BRUSSELS LONDON PARIS BUDAPEST PRAGUE WARSAW MOSCOW TOKYO

NEW YORK BALTIMORE MCLEAN MIAMI DENVER BOULDER COLORADO SPRINGS LOS ANGELES  
\\LA-81872/0004-140734 v1